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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,897	12/01/2000	Brent Tzion Hailpern	YOR9-2000-0582US1(8728-42	3671

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 06/08/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/727,897

Applicant(s)

HAILPERN ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 12/1/2000.
2. Claims 1-27 are pending in the case, claims 1, 13 and 23 are independent claims.

Drawings

3. This application, filed under former 37 CFR 1.60, lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
5. The disclosure is objected to because of the following informalities:
 - The disclosure recites "*publishing system node 203*" (page 9, lines 13 and 14, page 10 lines 1-2). Reference sign 203 in Figure 2 is directed toward "*Server Node*".

Appropriate correction is required.

Art Unit: 2178

6. The use of the following trademarks has been noted in this application:

- "Microsoft" on page 2, line 8.
- "Internet Explorer" on page 2, lines 8-9.
- "Lotus Word Pro" on page 11, line 6.
- "Lotus Notes" on page 21, line 20.
- "Federal Express" on page 21, line 21.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

8. Claims 1-11, 23, 26 and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. The claimed invention is so abstract and sweeping as to cover the method if practiced by a human operator assisted only by pencil and paper. The claims 1-11,

Art Unit: 2178

23, 26 and 27 do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process", is not patentable subject matter.

"Phenomena of nature, though just discovered, *"mental processes"*, abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (Emphasis added). *Gottschalk v. Benson*, 175 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing*, 162 U.S.P.Q. 571 (1969).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. "

11. Claims 8, 12 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. **Regarding claim 8**, the claim recites the limitation "*representing each hyperlink as a dimension*" (Page 24, line 18). There is insufficient antecedent basis for this limitation in the claim. Claim 8 is dependent upon claim 7, which is dependent upon claim 1. Claim 1 recites the limitation "*hyperlinked document*" (page 23, lines 4 and 7).

13. **Regarding claim 12**, the claim recites the limitation "*wherein the step of publishing includes*" (Page 24, line 18). There is insufficient antecedent basis for this limitation in the claim. Claim 12 is dependent upon claim 3, which is dependent upon claim 1. Claims 1 and 3 do not recite a "*publishing*" limitation.
14. **Regarding claim 26**, the claim recites the limitation "*determining copyright information of a collected.*" (Page 31, line 9). The claim is indefinite because the limitation appears incomplete. The examiner has interpreted the claimed limitation as "*collected document*".

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
- "A person shall be entitled to a patent unless –*
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."*
16. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Pirolli et al. US Patent 5,895,470, filed 4/9/1997, patented 4/20/1999 (hereinafter Pirolli).
17. **Regarding independent claim 1**, Pirolli recites: "*Referring to FIG. 2, the walker uses the Hypertext Transfer Protocol (HTTP) to request and retrieve a web page, step 201. The walker may also be able to access the pages from the local file system, bypassing the HTTP. The returned page is then parsed to extract hyperlinks*

to other pages, step 202. Links that point to pages within the Web locality are added to a list of pages to request and retrieve, step 203" (column 6, lines 8-15). Pirolli further recites: *"The meta-information for the page is also extracted and stored, step 204. The meta-information includes at least the following page meta-information: name, title, list of children (pages associated by hyperlinks), file size, and the time the page was last modified. The page is then added to a topology matrix, step 205. The topology matrix represents the page to page hypertext relations, and a set of meta-information called the meta-document vectors, which represents the meta-information for each Web page"* (column 6, lines 15-24).

18. **Regarding dependent claim 2**, Pirolli recites: *"These techniques may be used in support of various information visualization techniques, such as the WebBook described in co-pending and commonly assigned application Ser. No. 08/525, 936 entitled "Display System For Displaying Lists of Linked Documents", to form and present larger aggregates of related Web pages"* (column 2, lines 11-17).
19. **Regarding dependent claim 3**, Pirolli recites: *"Referring to FIG. 2, the walker uses the Hypertext Transfer Protocol (HTTP) to request and retrieve a web page, step 201. The walker may also be able to access the pages from the local file system, bypassing the HTTP. The returned page is then parsed to extract hyperlinks to other pages, step 202. Links that point to pages within the Web locality are added to a list of pages to request and retrieve, step 203"* (column 6, lines 8-15).

20. **Regarding dependent claim 5**, Pirolli recites: *"Referring to FIG. 2, the walker uses the Hypertext Transfer Protocol (HTTP) to request and retrieve a web page, step 201. The walker may also be able to access the pages from the local file system, bypassing the HTTP. The returned page is then parsed to extract hyperlinks to other pages, step 202. Links that point to pages within the Web locality are added to a list of pages to request and retrieve, step 203"* (column 6, lines 8-15).
21. **Regarding dependent claim 6**, Pirolli recites: *"Categorization techniques are based on representations of Web pages as feature vectors containing information about document content"* (column 2, lines 17-19). Compare *"Table of Contents"* to *"document contents"*.
22. **Regarding dependent claim 7**, Pirolli recites: *"These feature vectors are used to identify and rank particular kinds of Web pages, such as "organization home pages" or "index pages"* (column 2, lines 21-23).
23. **Regarding dependent claim 8**, Pirolli discloses in Figure 5, a table representing *"Inlinks"* and *"Outlinks"* at reference signs 504 and 505 respectively, as a dimension of a document (shown at reference sign 501 as *"Page 1"*, *"Page 2"* etc). Pirolli further discloses in Figure 5, at reference sign 506, the frequency of links, where the frequency is a coordinate of the hyperlink dimension. Pirolli discloses in figure 7, the clustering of documents as vectors.

Art Unit: 2178

24. **Regarding dependent claim 9**, Pirolli recites: "*The site's topology is ascertained via "the walker", an autonomous agent that, given a starting point, performs an exhaustive breadth-first traversal*" (column 6, lines 4-6).
25. **Regarding dependent claim 10**, Pirolli recites: "*cdepth, the average depth of the item's children as measured by the number of '/' in the URL (column 509)*" (column 8, lines 25-26).
26. **Regarding dependent claims 4 and 11**, the claims are rejected for fully incorporating the deficiencies of their base claims.
27. **Regarding dependent claim 12**, Pirolli recites: "*The meta-information for the page is also extracted and stored, step 204*" (column 6, lines 15-16).
28. **Regarding independent claim 13**, the claim is directed toward a computer program product for the method of claim 1, and is rejected with the same rationale.
29. **Regarding dependent claim 14**, the claim is directed toward a computer program product for the method of claim 7, and is rejected with the same rationale.
30. **Regarding dependent claim 15**, the claim is directed toward a computer program product for the method of claim 2, and is rejected with the same rationale.
31. **Regarding dependent claim 16**, the claim is directed toward a computer program product for the method of claim 3, and is rejected with the same rationale.

Art Unit: 2178

32. **Regarding dependent claim 17**, the claim is directed toward a computer program product for the method of claim 11, and is rejected with the same rationale.
33. **Regarding dependent claim 18**, the claim is directed toward a computer program product for the method of claim 6, and is rejected with the same rationale.
34. **Regarding dependent claim 19**, the claim is directed toward a computer program product for the method of claim 8, and is rejected with the same rationale.
35. **Regarding dependent claim 20**, the claim is directed toward a computer program product for the method of claim 9, and is rejected with the same rationale.
36. **Regarding dependent claim 21**, the claim is directed toward a computer program product for the method of claim 10, and is rejected with the same rationale.
37. **Regarding dependent claim 22**, the claim is directed toward a computer program product for the method of claim 12, and is rejected with the same rationale.
38. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

39. Claims 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Lapstun et al. US Patent 6,728,000, filed 5/23/2000, patented 4/27/2004 (hereinafter Lapstun).
40. **Regarding independent claim 23**, Lapstun recites: *"The presence of the most abstract document description on the page server allows a user to request a copy of a document"* (column 15, lines 3-5) and *"The operator can locate the desired document and route it to the user's printer. Depending on the document type, the publisher or the user pays the small "yellow pages" service fee"* (column 25, lines 64-67). Lapstun further recites: *"A document instance 831 corresponds to a formatted document 834. It consists of a set of page instances 830, each of which corresponds to a page description 5 of the formatted document. Each page instance 830 describes a single unique printed netpage 1, and records the page ID 50 of the netpage"* (column 15, lines 17-22) and *"provide a paper-based user interface to published information"* (column 10, lines 15-16).
41. **Regarding dependent claim 24**, Lapstun recites: *"As illustrated in FIG. 1, a printed netpage 1 can represent a interactive form which can be filled in by the user both physically, on the printed page, and "electronically", via communication between the pen and the netpage system. The example shows a "Request" form containing name and address fields and a submit button"* (column 8, lines 7-12).

42. **Regarding dependent claim 25**, Lapstun recites: "*The operator can locate the desired document and route it to the user's printer*" (column 25, lines 64-65).
43. **Regarding dependent claims 26 and 27**, Lapstun recites: "*The netpage system includes a mechanism for micro-payments, to allow the user to be conveniently charged for printing low-cost documents on demand and for copying copyright documents*" (column 36, lines 11-14).

Conclusion

44. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,781,914	07-1998	Stork et al.
• US-5,848,413	12-1998	Wolff, Gregory J.
• US-5,867,799	02-1999	Lang et al.
• US-5,870,552	02-1999	Dozier et al.
• US-5,895,470	04-1999	Pirolli et al.
• US-6,237,011	05-2001	Ferguson et al.
• US-6,393,469	05-2002	Dozier et al.
• US-6,415,278	07-2002	Sweet et al.
• US-6,507,410	01-2003	Robertson et al.
• US-6,601,075	07-2003	Huang et al.
• US-6,650,434	11-2003	Bruce, Stephen Robert
• US-6,728,000	04-2004	Lapstun et al.
• US-2002/0129058	09-2002	STORY et al.

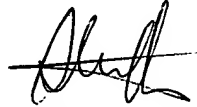
45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
May 27, 2004



STEPHEN S. HONG
PRIMARY EXAMINER